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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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PILLSBURY WINTHROP, LLP  
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MCLEAN, VA 22102

EXAMINER

TRINH, MINH N

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 07/17/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/912,455

Applicant(s)

LEBARIC ET AL.

CS

Examiner

Minh Trinh

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 13, 14 and 26-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 15-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                     | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                            | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4, 5</u> . | 6) <input type="checkbox"/> Other:  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of Species 1A and 2A (claims 1-12 and 15-25) in Paper No. 7 is acknowledged. The Patent Office agrees that claim 1 is generic claim and there are no species 2A in this application. In view of finding that the Restriction mailed in or about May 12, 2003 was proper and is correct and further in every of the fact that Applicant has not Argued the requirement for an election of species (see Paper No. 6, 1 paragraph). Note that Applicant is referred to an election of species at Section 808.01(a) in the MPEP, Which states that once claims are determined to be directed to mutually patentable inventions and the Office requires an election of species, a persuasive traverse is an admission on the record that Applicant did not demonstrate that the claimed species are individually patentable, examination of the independent inventions herein would present a serious burden to the Office in as much as the searches are not coextensive and the art is quite prolific Accordingly, the requirement is repeated and **made FINAL**.

2. Claims 13-14 and 26-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made with traverse in Paper No. 7, Applicant therefore is requested to cancel all non-elected claims or take other appropriate action.

An Office Action on the merits of claims 1-12 and 15-25 follows.

***Specification***

3. The disclosure is objected to because of the following informalities:

a) "Coping US applications Serial No. \_\_\_/\_\_\_ filed on \_\_\_\_, 2000"

(page 11, lines 17-18) should be updated.

b) and Serial No. \_\_\_/\_\_\_ filed on \_\_\_\_, 2000 (page 11, line 19) should be updated. Note that the above Applications are filed on July 24, 2001. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-12 and 15-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following are examples:

i) It is not clear whether "an antenna" (claim 1, line 6) is the same as "an antenna" (in the preamble, line 1).

ii) The phrase: "the design dimensions" should be change to: "design dimensions" for better clarification of the claimed subject matter.

iii) Many phrases are unclear and lack antecedent basis such as: "the operating wavelength"(claim 2, line 1); "the stem area" (claim 3, line 3); "the center"(claim 4, line 2), etc.

iv) The phrase: "capable of operating as an antenna" (claim 17, line 2) is not positively limitation. The Examiner suggests the phrase: "capable of operating as an antenna" should be changed to: --the antenna--.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3-12 and 15-25, as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al (US 5,181,044).

Matsumoto et al disclose a method of manufacturing antenna comprising: selecting design dimensions of a unitary piece of material according to an operating wavelength (see Fig. 5, and the discussed at col. 1, lines 37-46), the unitary piece comprising: a circular area having a center and an outer region; and a stem area having a first end 31B and a second end 36, the first end joined with the outer region, the unitary piece bendable at the first end 31 and the outer region (see Fig. 5); bending the unitary piece at the first end 31B and the outer region so that the circular perpendicular to the stem area as recited in claim 3 (see Fig. 5, shows at least the first end being perpendicular to the circular area); the design dimensions comprise; a radius defined from the center to a point on the outer region along a radial axis as recited in claim 4 (see Fig. 5, shown the antenna 10B defining a radius from the center point of the

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antenna 10B along its radial axis); the stem area protrudes outward from the outer region along the radial axis as recited in claims 7-9 (see Fig. 5, which shows the stem area protrudes outward from the radial axis (center axis of 10B)); and the limitation as recited in claims 12, (see Fig. 5, which shows the stem area being equivalent to a second width at the second stem end 36 of the stem area). Matsumoto et al inherently disclose the stamping out the unitary piece of material 10B from a large section according to the design dimensions as so to form the antenna (see Fig. 5, and the discussion at col. 1, lines 15-58). Note that Matsumoto et al 's references 30B and 31B read on the claimed stem area of the instant claims.

Limitations of claims 3-4, 7-9 and 12 are also met as set forth above.

As applied to claims 5 and 6, with respect to the radius being approximately equal to  $1/12$  and/or  $1/13$  of the operating wavelength as recited in claims 12 and 13. It is held to be mere design choice to choose any desired radius configuration since Applicant has not indicated that the claimed radius configuration as recited in the claims 5-6 would solve any stated problem or is for any particular purpose. It also appears that the invention would perform equally well with the configurations as taught by the prior art references (see Matsumoto et al 's Fig. 5). Furthermore, it held to be design choice to choose any desired radius from the center of the antenna of whatever size and/or configuration as is desired. A change in size within Patent Law is recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47 and therefore does not support patentability.

As applied to claims 10-11, with respect to the stem length being approximately equal to  $1/12$  and/or  $1/13$  of the operating wavelength. It is held to be mere design choice to choose any desired stem length with respect to the operating wavelength since Applicants have not indicated that the exact stem length would solve any stated problem or is for any particular purpose. It also appears that the invention would perform equally well with the stem configurations as taught by the prior art references (see Matsumoto et al 's Fig. 5).

As applied to claims 15-17 and 18, Matsumoto et al disclose the larger section material is planar as recited in claims 15 and 18 (see the discussion at col. 1, lines 50-52); the unitary piece 10B is planar prior to bending of the unitary piece as recited in claim 16 (see Fig. 5, col. 6, lines 46-49); the bending unitary piece into the antenna as recited in claim 17 (see Fig. 5, shows the bending 31B and 36 of the unitary piece to form the antenna).

As applied to claims 19-23, Matsumoto et al disclose a foot area 36 and the stem area 30B or 31B being perpendicular to the foot area 36 as recited in claims 19-21 (see Fig. 5, which shows the first end 30B being bent so that the circular area is perpendicular to the stem area 30B); bending the unitary piece at the third end (where 36 meets with 31B) and the second end 31B so that the stem area 30B or 31B is perpendicular to the foot area 36 as recited in claim 22 (see Fig. 5); and that as recited in claim 23.

As applied to claims 24-25, Matsumoto et al' Fig. 5, which shows a first width of the stem area 31B being equivalent to a second width at the second stem end 36 of the

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stem area; and a third width at the first end of the stem area 30B is equal to the first width at the second end of the stem area 31B (see Fig. 5).

8. Claims 2, as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al (US 5,181,044) in view of Applicant Admitted Prior Art [APA] (see Applicants' Specification page 2).

As applied to claim 2, Matsumoto et al as applied and relied upon above do not teach the step of determining the operating wavelength from an operating frequency; the APA teaches the determining the operating wavelength from an operating frequency (see Applicants' specification page 2, lines 5-10). Therefore, it would have been obvious to one having an ordinary skill in the art, at the time of the invention to combine the two teachings and to modify the invention of Matsumoto et al by employing the teaching of the APA's determining the operating wavelength from an operating frequency in order to obtain the antenna structure with a desired operating frequency, efficiency of the operations would result.

### ***Prior Art References***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art references are cited for their teaching of method of manufacturing antenna stem.

### ***Conclusion***



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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887.

The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7307 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

A handwritten signature in black ink, appearing to read 'M. Trinh', with a long horizontal stroke extending to the right.

M. Trinh  
Patent Examiner Group 3700

mt  
July 8, 2003